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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,569	07/31/2001	Thomas Blakeley	604.14-US1	4695

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/890,569

**Applicant(s)**

BLAKELEY ET AL.

**Examiner**

Clement B Graham

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. Claims 12, are remained.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over (Stewart (U. S. Patent No 6,104,722) in view of Kohorn ( U.S. Patent No 5, 508, 731).

As per claim 1-3, 12, Stewart discloses a method of virtual prospecting comprising;

the third party. ("i. e, first node") electronically communicating the selected commercial to the selected prospect. ("i. e, second node") the selected prospect making. (i. e, communicating") a response to the selected commercial. (see column 8 lines 45-60) the third party tracking. (i.e. control node see column 2 line 40) the response made by the selected prospect. ("i. e, second node") and the third party reporting back to the advertiser. ("i. e, third node") with information relating to response to the selected commercial. (see column 8 lines 45-60).

Stewart fail to teach an advertiser narrowly making a selection of a prospect and a commercial, and identifying the selection to a third party.

However Kohorn discloses providing a member of the audience with a means for entering a response to a situation viewed on the television screen and/or heard via the speaker, not accepting (rejecting) or accepting, evaluating and scoring such response, recording such response, and outputting a temporary or permanent record of the response, and a permanent record is in the form of the card, which form is machine readable to facilitate a reading of the score and/or response by either a third party or the host. (See column 18 lines 10-15) communicating the identities of a winner selection station. (See column 128 lines 40-50).

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart to include Kohorn in order to an advertiser manually selecting an individual prospect and an individual commercial, and identifying the selection to a third party taught by Kohorn in order for the third party to transmit the selection decision information that was made by the advertiser to the individual prospect, and retransmitting a response from the prospect to the advertiser.

As per claim 4, Stewart and Kohorn do not explicitly teach do not explicitly teach the method of claim 1 wherein the commercial is an executable file.

However the commercial into an executable file is old and well known in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of the commercial into an executable file.

The benefit would have been to convert the commercial in to a executable file for transmission or access to that executable.

As per claim 5, Stewart fail to explicitly teach the commercial includes an identification code.

However Kohorn discloses as an illustration, a TV-viewer having a response unit (as described above) in his home, is provided with two materials or matrices to form hard copy outputted by the dispenser. For example, the matrices may be a paper tape comprised of coupon sections, which tape is fed into the printer of the response unit, and a verification card having spaces or boxes. The coupons and the card have the name or other identification of the TV-viewer imprinted thereon. Codes can be provided on both the tapes and cards. (see column 20 lines 45-55).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart to include identification code in a commercial taught by Kohorn in order to identify the commercial.

As per claim 6, Stewart and Kohorn do not explicitly teach the commercial is communicated to the prospect as an attachment to an e-mail.

However commercial is communication to the prospect as an attachment to an e-mail is old and well known in the art of communication because it provide an efficient and effective means of communicating.

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart and Kohorn to include communicating a commercial to a prospect as an attachment to an e-mail because it provides an efficient and effective means of communicating.

As per claim 7, Stewart and Kohorn do not explicitly teach the commercial includes a hyperlink to a web site.

However commercial includes a hyperlink to a web site are old well known in the art because the hyperlink is a directory to a web site that provides access to information on places such as the internet.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart and Kohorn to include hyperlink to a web site. because the hyperlink is a directory to a web site that provides access to information on places such as the internet.

As per claim 8, Stewart discloses the step of tracking includes determining whether a commercial is opened.( see column 2 line 40).

As per claim 9, Stewart and Kohorn do not explicitly teach the step of tracking includes initiating a substantially synchronous link between the prospect and the agent. (see column 2 line 40 and column 8 lines 45-60).

As per claim 10, Stewart and Kohorn do not explicitly teach the substantially synchronous link comprises a telephone call.

However substantially synchronous link comprises a telephone call is old and well known in the art of communication because they provide communication between two parties. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart and Kohorn to include substantially synchronous link comprises a telephone call because they provide communication between two parties.

As per claim 11, Stewart and Kohorn do not explicitly teach the substantially synchronous link comprises a chat site.

However substantially synchronous link comprises a chat site is old and well known in the art of communication because they provide communication between two parties.

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stewart and Kohorn to include substantially synchronous link comprises a chat site because they provide communication between two parties.

#### Conclusion

#### Response to Arguments

4. Applicant's arguments files on 12/08/03 have been fully considered but they are not persuasive for the following reasons.

5. In response to applicant's arguments regarding Stewart and Kohorn.

In response to Applicant's arguments Stewart teaches the third party electronically communicating the selected commercial to the selected prospect the selected prospect making a response to the selected commercial.see column 8 lines 45-60.

Stewart teaches the third party tracking the response made by the selected prospect and the third party reporting back to the advertiser with information relating to response to the selected commercial.see column 8 lines 45-60.

In response to Applicant's arguments that Kohorn fails to teach an advertiser narrowly making a selection of a prospect and a commercial, and identifying the selection to a third party.(see column 18 lines 10-15 and column 128 lines 40-50). Therefore it is clear that Stewart and Kohorn teaches the claimed invention of communication between a third party, advertiser and a prospect.

In response to Applicant's arguments that Stewart fails to teach "an advertiser manually selecting an individual prospect and an individual commercial and identifying that selection to a third party " this limitation is taught by Kohorn in column 18 lines 10-15 and column 128 lines 40-50).

In response to Applicant's arguments that the prospect recited in claim 1 is an entity the examiner submits that the type or name of the prospect does not change the main communication functions of the system.

6. With respect to Applicant's argument, that the examiner fail to establish prima facie case of obviousness, Examiner respectfully submits that obviousness is not

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determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ\* 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood*, 28 USPQ2d 1300(Bd. Pat. App &.,4/293 Therefore the combination of reference is proper and the rejection is maintained.

7. In response to applicant arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on a combination of references. See *In Keller*, 642 F.2d, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPTQ 375 (Fed. Cir. 1986).

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

March 22, 2004

  
HYUNG SOUGH  
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